

Appln. No. 10/783,437
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Response filed October 7, 2010
Reply to Office action mailed July 7, 2010

REMARKS

Claims 22-40 and 42-69 are pending in the Application and all have been rejected in the Office action of July 7, 2010. No claims are amended by this response. Claims 22, 47, and 60 are independent claims. Claims 23-40 and 42-46, 48-59, and 61-69 depend, respectively, from independent claims 22, 47, and 60. Applicants respectfully request reconsideration of claims 22-40 and 42-69, in view of the following remarks.

Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is **essential** that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, USPTO personnel should state all reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, USPTO personnel should indicate how rejections may be overcome and how problems may be resolved. **A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.**

M.P.E.P. § 2106(II) (emphasis added).

As such, the Applicants assume, based on the goals of patent examination noted above, that the current Office Action sets forth “all reasons and bases” for rejecting the claims.

Applicants respectfully submit that the pending claims are allowable over the cited art, for at least the reasons set forth below.

Amendments to the Specification

Applicants have amended the Specification as shown above to update information about related applications. Applicants respectfully submit that these amendments do not add new matter.

Rejections of Claims

Claims 22-25, 27, 29-34, 37-40, 43, 45-52, 54-63, 65, 68, and 69 were rejected under 35 U.S.C. §102(e) as being anticipated by Iwami, *et al.* (US 5,604,737, hereinafter "Iwami"). Claims 26 and 64 were rejected under 35 U.S.C. §103(a) as being unpatentable over Iwami in view of Lev, *et al.* (US 5,729,544, hereinafter "Lev"). Claims 28, 53, and 66 was rejected under 35 U.S.C. §103(a) as being unpatentable over Iwami and Official Notice. Claim 35 was rejected under 35 U.S.C. §103(a) as being unpatentable over Iwami in view of Barak (US 5,764,741). Claim 36 was rejected under 35 U.S.C. §103(a) as being unpatentable over Iwami in view of Fleischer, III *et al.* (US 5,592,541, hereinafter "Fleischer, III"). Claim 42 was rejected under 35 U.S.C. §103(a) as being unpatentable over Iwami in view of Sharman (US 5,774,854). Claim 44 was rejected under 35 U.S.C. §103(a) as being unpatentable over Iwami in view of Baum, *et al.* (US 5,761,281, hereinafter "Baum"). Claim 67 was rejected under 35 U.S.C. §103(a) as being unpatentable over Iwami in view of Baum.

I. Iwami Does Not Anticipate Claims 22-25, 27, 29-34, 37-40, 43, 45-52, 54-63, 65, 68, And 69

Claims 22-25, 27, 29-34, 37-40, 43, 45-52, 54-63, 65, 68, and 69 were rejected under 35 U.S.C. §102(e) as being anticipated by Iwami. Applicants respectfully traverse the rejection.

With regard to the anticipation rejections, MPEP 2131 states, "[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, **in a single prior art reference.**" *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). "The **identical** invention must be shown in as complete detail as is contained in ... the claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9

USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Further, “[t]he elements **must be arranged as required by the claim**, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required.” MPEP § 2131 (citing *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990) (emphasis added)).

With regard to independent claim 22, Applicants respectfully submit that claim 22 recites, in part, “[a] communication system controller comprising: ... interface circuitry for communicating, with an information transmission device, information requesting setup of a call and parameters for configuring the information transmission device, wherein the parameters for configuring the information transmission device comprise information specifically related to the conversion, by the information transmission device, of digitized voice information into an analog voice signal, and of an analog voice signal into digitized voice information,” and “at least one processor operably coupled to the interface circuitry.” Applicants respectfully submit that claims 47 and 60 recite similar features. Applicants respectfully submit that the Iwami does not teach, suggest, or disclose all aspects of Applicants’ claim 22, for a number of reasons.

Initially, Applicants respectfully submit that the Office fails to even mention Applicants’ claimed “at least one processor operably coupled to the interface circuitry,” let alone identify any support in the cited art, or set forth any arguments for the rejection of this aspect of claim 22. Applicants respectfully submit that the rejection of claim 22 fails, and that claim 22 is allowable, for this reason alone. Notwithstanding, Applicants now address other shortcomings of Iwami.

The Office rejected aspects of Applicants’ claim 22 at pages 2-3 of the Office action stating, in part:

Regarding claim 22, Regarding claim 22, Iwami et al. disclose a communication system controller comprising: interface circuitry for communicating, with an information transmission device, information requesting setup of a call **(see col. 11 lines 4-9)** and parameters for configuring the information transmission device **(see col. 17 lines 20-25; parameters are set to messages to specify an communication address; based on this address, the server determines the communication terminal and process voice in protocol in which the terminal**

connected); wherein the parameters for configuring the information transmission device comprise information specifically related to the conversion, by the information transmission device, of digitized voice information into an analog voice signal, and an analog voice signal into digitized voice information (see col. 3 lines 23-52; a parameter an extension number is for specifying a communication terminal; based on the terminal address, communication control is performed to connect the telephone with the communication terminal; voice information is converted into packets for transmitting to the communication terminal and vice versa);

(emphasis in original)

Applicants respectfully submit that the Office fails to specifically identify the elements of Iwami that allegedly teach Applicants' claimed "communication system controller," "interface circuitry," and "information transmission device." The Office seemingly identifies Iwami at col. 11, lines 4-9 as teaching all of those elements of claim 22. Iwami at col. 11, lines 4-17 recites the following (cited portion underlined):

The voice communication server program 22 is a program for accepting a call setting request from a telephone received from the public network communication controller 21 or a voice communication request from a communication terminal through the LAN communication controller 14 connected to the internal bus 19, editing voice packets transmitted from the telephone into voice packets, transmitting the voice packets to the communication terminal, converting voice packets received from the communication terminal to voice information, and transmitting the voice information to the telephone, thus providing voice communication functions between the communication terminal connected to the LAN 1 and the telephone connected to the public network 3, similar to the conventional functions between telephones.

(emphasis added)

The portion of Iwami shown above describes elements of FIG. 7, teaching of a "communication server program 22" that accepts a "call setting request" from a telephone via a "public network communication controller 21" or a "voice communication

request” from a “communication terminal” via the “LAN communication controller 14.” Because the “communication server program 22,” “public network communication controller 21,” and “LAN communication controller 14” are all elements of the “communication server 20” of FIG. 6 of Iwami, Applicants understand the Office to be asserting that the “communication server 20” teaches Applicants’ claimed “communication system controller” of claim 22. **If Applicants’ reading of the Office action is in error, Applicants respectfully request that the Office clearly identify the elements of Iwami that allegedly correspond to each element of Applicants’ claims in any future Office action, should one be forthcoming. Applicants respectfully submit that without clear identification, Applicants cannot fairly review the teachings of the references in relation to the claims.**

Applicants’ claim 22 recites that Applicants’ claimed “communication system controller” comprises, in part, “interface circuitry for communicating, with an information transmission device, information requesting setup of a call and parameters for configuring the information transmission device....” Applicants respectfully submit that Applicants’ claim 22 also recites that Applicants’ “communication system controller” comprises, in part, “operational software executable by the at least one processor, the operational software causing the at least one processor to produce the parameters for configuring the information transmission device based upon the information requesting setup of a call....”

The Office action seems to identify an “extension number” of Iwami as teaching Applicants’ “parameters,” citing Iwami at col. 17, lines 20-25 and col. 3, lines 23-52. Applicants now address those portions of Iwami, beginning with col. 17, lines 20-25, which are reproduced, underlined in context, below:

Assume, in this example, that the communication network is ISDN (Integrated Services Digital Network). In accordance with the ISDN, a variety of parameters can be set to messages running through the line. Thus, in this example, an extension number specified by the user is added to user information or communication address in a call setting request sent from a telephone, so that the call setting request is transmitted together with the extension number. In the connected communication terminal

determination processing of FIG. 23, the extension number in the call setting request is acquired for determining a communication terminal.

(emphasis added)

The portion of Iwami shown above teaches that in an ISDN, a variety of parameters can be set to messages, and that an "extension number" specified by a user may be added to "user information" or a "communication address" in a "call setting request" sent from a telephone, so that the "call setting request" from the telephone is sent together with the "extension number." Iwami also teaches that the "communication terminal determination processing" of FIG. 23 acquires the "extension number" for determining the "communication terminal." Applicants respectfully note that FIG. 23 of Iwami shows further detail of the processing of "Step 203" of FIG. 8, which Iwami describes as a "flow chart showing the processing of a voice communication program on the communication server for starting a voice communication between a communication network on LAN and the telephone, upon receiving a call setting request from a telephone connected to a public network." Therefore, the cited portion of Iwami at col. 17, lines 20-25 describes actions of the "communication server program 22" running on "communication server 20," which the Office has identified as teaching Applicants' claimed "communication system controller." That is, Iwami teaches that the "extension number," which the Office asserts teaches Applicants' claimed "parameters," is sent by a telephone, and received by the "communication server 20." Applicants' claim 22 requires, however, that the "operational software executable by the at least one processor," causes the "at least one processor [of the claimed "communication system controller"] to produce the parameters for configuring the information transmission device based upon the information requesting setup of a call..." Thus, the teaching of the cited portion of Iwami at col. 17, lines 20-25 **is contrary to and cannot teach** the language of Applicants' claim 22.

Applicants now address Iwami at cited col. 3, lines 23-52, which is shown below:

When the line switching network is ISDN (Integrated Services Digital Network), a telephone may transmit a voice communication request including as a parameter an extension number for specifying a communication terminal to

the communication server, such that the communication server finds the communication terminal address of a communication terminal to be connected from the extension number included in the voice communication request.

Instead of assigning an extension number, a unique telephone number may be assigned to each of communication terminals connected to the packet switching network. In this case, although these telephone numbers are actually assigned to the communication server, they are regarded as telephone numbers of communication terminals from the user. Then, when a telephone number of a communication terminal is inputted from a telephone, the communication control is performed between the telephone and the communication server, wherein the communication server finds a communication terminal address from the telephone number inputted from the telephone, determines a communication terminal to be connected, and transmits a voice communication request to the communication terminal. This control enables a communication between the telephone and the communication terminal through the communication server. Thereafter, the communication server receives voice information transmitted from the telephone, edits the voice information into packets, and transmits the packets to the communication terminal. The communication server also receives packets transmitted from the communication terminal, and transmits voice information in the packets to the telephone. In this way, communication is carried out.

(emphasis added)

The cited portion of Iwami shown above again teaches that a “voice communication request” includes an “extension number” for specifying a communication terminal parameter to the “communication server.” Iwami states that the “communication server” finds the “communication terminal address” of a communication terminal to be connected from the “extension number” included in the “voice communication request.” In addition, Iwami teaches that instead of assigning an “extension number,” a “unique telephone number” may be assigned to each of communication terminals. Thus, this portion of Iwami is consistent with Iwami at col. 17, lines 20-25, in that Iwami teaches that the “telephone” **sends** a parameter of either an “extension number” or a “unique telephone number” **to** the “communication server.” Applicants again respectfully submit that Applicants’ claim 22 requires that the

“operational software executable by the at least one processor,” causes the “at least one processor [of the claimed “communication system controller”] to produce the parameters for configuring the information transmission device based upon the information requesting setup of a call....” Thus, the teaching of the cited portion of Iwami at col. 3, lines 23-52 **is also contrary to and cannot teach** the language of Applicants’ claim 22.

Therefore, based at least upon the above, Applicants respectfully submit that the portions of Iwami specifically cited by the Office fail to support the argument by the Office that Iwami teaches Applicants’ feature of claim 22 that recites “parameters for configuring the information transmission device.” Applicants respectfully note that a claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, **in a single prior art reference**. Applicants respectfully submit that Iwami does not teach each and every element of Applicants’ claim 22. Therefore, Applicants respectfully submit that Iwami does not anticipate claim 22, and that claim 22, and any claims that depend therefrom, are allowable over Iwami. Applicants respectfully submit that claim 22 is allowable for at least an additional reason.

Applicants respectfully submit that claim 22 also recites “...wherein the parameters for configuring the information transmission device comprise information specifically related to the conversion, by the information transmission device, of digitized voice information into an analog voice signal, and of an analog voice signal into digitized voice information....” The Office asserts that the portion of Iwami at col. 3, lines 23-52, reproduced above, also teaches this aspect of Applicants’ claim 22. Applicants respectfully disagree. Applicants respectfully submit that the cited portion of Iwami, shown above, fails to make any mention of “conversion,” or of “conversion of digitized voice information in to an analog voice signal,” or conversion “of an analog voice signal into digitized voice information.” Further, the cited portion of Iwami fails to provide any support for the assertion the “extension number” or “unique telephone number” of Iwami are “parameters” that comprise **information specifically related to the conversion**, by the information transmission device, of digitized voice information into an analog voice signal, and of an analog voice signal into digitized voice information,” as required by

claim 22. Iwami instead teaches that the “extension number” or “unique telephone number” are used “for specifying a communication terminal to the communication server.” Therefore, Applicants respectfully submit that the cited teachings of Iwami do not disclose at least these aspects of Applicants’ claim 22, that Iwami fails to teach each and every element of Applicants’ claim 22, and that Iwami does not anticipate claim 22. Therefore, for at least these reasons, Applicants respectfully submit that claim 22, and any claims that depend therefrom, are allowable over Iwami for at least these additional reasons. Applicants respectfully submit that claim 22 is allowable for at least an additional reason.

As noted above, Applicants’ claim 22 also recites a “communication system controller” that comprises, in part, “operational software executable by the at least one processor, the operational software causing the at least one processor to produce the parameters for configuring the information transmission device based upon the information requesting setup of a call....” The Office action rejects this aspect of claim 22 at page 3, citing Iwami at col. 17, lines 21-26, and stating “information generated with extension number (parameter) to be transmitted to the server.” (emphasis added) The Office seemingly recognizes that the “extension number,” which the Office has asserted as teaching Applicants’ claimed “parameters,” is sent to the “communication server” of Iwami, which the Office has asserted teaches Applicants claimed “communication system controller.” As discussed above, however, Applicants’ claim 22 recites the “operational software” as being part of the “communication system controller” and “executable by the at least one processor.” Therefore, the “extension number” of Iwami, **sent** from the telephone **to** the “communication server” of Iwami **cannot teach** Applicants’ claimed “parameters” and the “operational software [of the communication system controller]” that “produce[s] the parameters,” of claim 22. For at least these reasons, Applicants respectfully submit that the cited portion of Iwami at col. 17, lines 21-26, specifically selected by the Office, does not teach at least this aspect of Applicants’ claim 22, that Iwami therefore does not teach each and every aspect of claim 22, and that Iwami therefore does not anticipate claim 22. Accordingly, Applicants respectfully submit that claim 22, and any claims that depend therefrom, are allowable over Iwami for at least this additional reason.

Based at least upon the above, Applicants respectfully submit that the Office has not demonstrated that Iwami teaches each and every aspect of Applicants' claim 22, has therefore not established a *prima facie* case of anticipation as required by M.P.E.P. §2131, and that claim 22 is allowable over Iwami. Because claims 23-40 and 42-46 depend from claim 22, Applicants respectfully submit that those claims are allowable as well.

With regard to independent claims 47 and 60, Applicants respectfully submit that claims 47 and 60 were rejected over the same art for the same reasons set forth in the rejection of claim 22, and that claims 47 and 60 are allowable over the cited art for the same reasons set forth above. Further because claims 48-59, and 61-69 depend from claims 47 and 60, Applicants respectfully submit that those claims are also allowable over Iwami, for at least the same reasons.

Therefore, for at least the reasons presented above, Applicants respectfully submit that claims 22-40 and 42-69 are allowable over the cited art, and respectfully request that the rejection of claims 22-25, 27, 29-34, 37-40, 43, 45-52, 54-63, 65, 68, and 69 under 35 U.S.C. §102(e) be reconsidered and withdrawn.

II. The Proposed Combination of Iwami And Lev Does Not Render Claims 26 And 64 Unpatentable

Claims 26 and 64 were rejected under 35 U.S.C. §103(a) as being unpatentable over Iwami in view of Lev. Applicants respectfully traverse the rejection. Claims 26 and 64 depend, respectively, from claims 22 and 60. Applicants respectfully submit that claims 22 and 60 are allowable over the cited art, because the Office has not demonstrated that Lev remedies the shortcomings of Iwami set forth above. Because claims 22 and 60 are allowable over the cited art, Applicants respectfully submit that claims 26 and 64 that depend therefrom are also allowable, for at least the same reasons. Accordingly, Applicants respectfully request that the rejection of claims 26 and 64 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

III. The Proposed Combination of Iwami And Official Notice Does Not Render Claims 28, 53, And 66 Unpatentable

Claims 28, 53, and 66 were rejected under 35 U.S.C. §103(a) as being unpatentable over Iwami in view of Official Notice. Applicants respectfully traverse the rejection. Applicants respectfully challenge the assertion of Official Notice that “it is well-known in the art to utilize analog signals in conventional communication network” in the context of claims 28, 53, and 66. See Office action at page 10. Applicants respectfully submit that the Office has failed to show any support for the assertion that, in the context of claims 28, 53, and 66, Applicants’ claimed feature is, in fact, “well-known in the art.” Indeed, Applicants respectfully submit that if Applicants’ claimed feature was well-known in the relevant art at the time of the invention, the search of the prior art performed by the Office in its obligation under 37 C.F.R. §1.104 would have revealed such teachings. Because the Office, in spite of its obligation to identify any such prior art has not cited such art, Applicants must conclude that no such art exists, otherwise the Office would have made such art of record. However, if the assertion that Applicants’ claimed feature is “well-known in the art” arises from the personal knowledge of the Examiner, the Examiner must attest to the nature of such knowledge, or withdraw the rejection. See M.P.E.P. §2144.03.

Notwithstanding the above, Applicants respectfully submit that claims 28, 53, and 66 depend, respectively, from claims 22, 47, and 60. Applicants respectfully submit that claims 22, 47, and 60 are allowable over the cited art, because the Office has not demonstrated that the alleged facts of the Official Notice set forth by the Office remedy the shortcomings of Iwami set forth above. Because claims 22, 47, and 60 are allowable over the cited art, Applicants respectfully submit that claims 28, 53, and 66 that depend therefrom are also allowable, for at least the same reasons. Accordingly, Applicants respectfully request that the rejection of claims 28, 53, and 66 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

IV. The Proposed Combination of Iwami And Barak Does Not Render Claim 35 Unpatentable

Claim 35 was rejected under 35 U.S.C. §103(a) as being unpatentable over Iwami in view of Barak. Applicants respectfully traverse the rejection. Claim 35 depends from claim 22. Applicants respectfully submit that claim 22 is allowable over the cited art, because the Office has not demonstrated that Barak remedies the shortcomings of Iwami set forth above. Because claim 22 is allowable over the cited art, Applicants respectfully submit that claim 35 that depends therefrom is also allowable, for at least the same reasons. Accordingly, Applicants respectfully request that the rejection of claim 35 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

V. The Proposed Combination of Iwami And Fleischer III Does Not Render Claim 36 Unpatentable

Claim 36 was rejected under 35 U.S.C. §103(a) as being unpatentable over Iwami in view of Fleischer III. Applicants respectfully traverse the rejection. Claim 36 depends from claim 22. Applicants respectfully submit that claim 22 is allowable over the cited art, because the Office has not demonstrated that Fleischer III remedies the shortcomings of Iwami set forth above. Because claim 22 is allowable over the cited art, Applicants respectfully submit that claim 36 that depends therefrom is also allowable, for at least the same reasons. Accordingly, Applicants respectfully request that the rejection of claim 36 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

VI. The Proposed Combination of Iwami And Sharman Does Not Render Claim 42 Unpatentable

Claim 42 was rejected under 35 U.S.C. §103(a) as being unpatentable over Iwami in view of Sharman. Applicants respectfully traverse the rejection. Claim 42 depends from claim 22. Applicants respectfully submit that claim 22 is allowable over the cited art, because the Office has not demonstrated that Sharman remedies the shortcomings of Iwami set forth above. Because claim 22 is allowable over the cited art, Applicants respectfully submit that claim 42 that depends therefrom is also allowable, for at least the

same reasons. Accordingly, Applicants respectfully request that the rejection of claim 42 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

VII. The Proposed Combination of Iwami And Baum Does Not Render Claim 44 Unpatentable

Claim 44 was rejected under 35 U.S.C. §103(a) as being unpatentable over Iwami in view of Baum. Applicants respectfully traverse the rejection. Claim 44 depends from claim 22. Applicants respectfully submit that claim 22 is allowable over the cited art, because the Office has not demonstrated that Baum remedies the shortcomings of Iwami set forth above. Because claim 22 is allowable over the cited art, Applicants respectfully submit that claim 44 that depends therefrom is also allowable, for at least the same reasons. Accordingly, Applicants respectfully request that the rejection of claim 44 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

VIII. The Proposed Combination of Iwami And Baum Does Not Render Claim 67 Unpatentable

Claim 67 was rejected under 35 U.S.C. §103(a) as being unpatentable over Iwami in view of Baum. Applicants respectfully traverse the rejection. Claim 67 depends from claim 60. Applicants respectfully submit that claim 60 is allowable over the cited art, because the Office has not demonstrated that Baum remedies the shortcomings of Iwami set forth above. Because claim 60 is allowable over the cited art, Applicants respectfully submit that claim 67 that depends therefrom is also allowable, for at least the same reasons.

In addition, Applicants respectfully submit that claim 67 recites, in part, “prompting the user for routing information, if routing information corresponding to the destination address is not available.” Applicants have previously addressed the alleged teachings of Baum with respect to claim 67. See Applicants’ response of April 5, 2010. The instant Office action admits that Iwami does not teach at least this aspect of Applicants’ claim 67. See Office action at page 14. The Office once again cites Baum at col. 21, lines 54-60 as teaching this aspect of claim 67. The cited portion of Baum states the following:

Computer C1 of call originator 20 provides call set-up information, including the telephone 55 number assigned to computer C5, and transmits digital data signals representing digital data to modem M1. Assume that computer C5 is available on number 950-XXXX. Modem M1 converts the set-up information and digital data to analog telephone signals on line 40.

Applicants respectfully maintain that the cited portion of Baum shown above fails to teach, suggest, or disclose prompting a user, as claimed. Instead, the cited portion of Baum teaches that "computer C1" provides "call set-up information," which is different from and does not teach **prompting a user** "if routing information corresponding to the destination address is not available," as required by claim 67. Thus, Applicants believe that claim 67 is independently allowable over Baum, and request reconsideration and withdrawal of the rejection of claim 67.

In maintaining the rejection of claim 67, the Advisory action mailed March 30, 2010 states, in part, the following about the teachings of Baum:

On page 22 of the Applicant's remarks regarding claim 67, Applicant argues that Baum fails to teach, suggest, or disclose prompting a user as claimed. Instead Baum teaches that computer provides call set-up information which is different than prompting a user for the routing information. The Examiner respectfully disagrees since Baum discloses the computer to provide call set-up information (control signal). The computer user may input this control signal directly (col. 2, lines 54-55). The call original [sic] may be prompted to notify what to do with the controls signals (col. 26 lines 63-64). Thus Baum discloses prompting the user for call set-up information (routing information).

Applicants respectfully submit that Applicants' claim 67 recites the following:

The machine-readable storage of claim 60 wherein the determining comprises:

determining whether routing information corresponding to the destination address is available using the stored routing information and the destination address;

prompting the user for routing information, if routing information corresponding to the destination address is not available; and

refraining from prompting the user, if routing information corresponding to the destination address is available.

As shown above, the Office admits that “Baum discloses **the computer** to [sic] provide call set-up information,” citing Baum at col. 2 lines 54-55. (emphasis added) Initially, Applicants respectfully submit that Baum states, at cited col. 2, lines 54-55, “[t]echniques are becoming available whereby a remote computer user may input control signals directly into the telephone line.” Applicants respectfully submit that the cited portion simply states that a user inputs “control signals” directly to a telephone line, and that the Office fails to explain how and why this portion of Baum teaches that the user was “prompted” to do so, and even further, how and why the cited portion of Baum teaches prompting the user “for routing information, if routing information corresponding to the destination address is not available,” as claimed.

The Advisory action of March 30, 2010 also cites Baum at col. 26, lines 63-64 as support for maintaining the rejection of claim 67. This cited portion of Baum states, “[this feature allows the host computer system 60 to look up the profile of the call originator, send data or prompts to the call] originator, or whatever the user may wish to do with the control signals.” (emphasis added) Even if Applicants were to agree that Baum teaches what is asserted, namely, that “[t]he call original [sic, originator] may be prompted to notify what to do with the controls signals,” **which Applicants do not**, Applicants respectfully submit that prompting a user “to notify what to do with the controls signals” cannot be stretched so far as to teach “prompting the user for routing information, if routing information corresponding to the destination address is not available,” as claimed. Baum simply does not teach or suggest that a user might want to prompt the user for routing information, as more fully recited by claim 22. Further, there is no teaching, suggestion, or disclosure of refraining from prompting, if such “routing information” is determined to be available.

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Because the Office admitted that Iwami fails to teach the subject matter of claim 67, and Applicants have now shown that Baum also does not teach at least some of the aspects of claim 67 admittedly missing from Iwami, Applicants respectfully submit that the proposed combination of Iwami and Baum cannot teach all aspects of Applicants' claim 67. Thus, for at least the above reasons, Applicants respectfully submit that claim 67 is independently allowable over the cited art. Accordingly, Applicants respectfully request that the rejection of claim 67 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Conclusion

In general, the Office Action makes various statements regarding the claims and the cited references that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

Applicants believe that all of pending claims 22-40 and 42-69 are in condition for allowance. Should the Examiner disagree or have any questions regarding this submission, the Applicants invite the Examiner to telephone the undersigned at (312) 775-8000.

A Notice of Allowability is courteously solicited.

The Commissioner is hereby authorized to charge any fees required by this submission to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

Dated: October 7, 2010

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